Docket No.: 100200074-1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Nancy Cheung et al.

Application No.: 09/993,277

Confirmation No.: 6352

Filed: 11/05/2001

Art Unit: 2155

For: SYSTEM AND METHOD FOR ROUTING
MESSAGES TO APPROPRIATE ONES OF
GEOGRAPHICALLY DISTRIBUTED EMAIL
SERVERS

Examiner: David Y. Eng

REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.41(a)(1), this Reply Brief is filed within two months of the
Examiner's Answer dated August 9, 2006.

No fee is required for this REPLY BRIEF.

This brief contains items under the following headings pursuant to M.P.E.P. § 1208:

I.	Status of Claims
II	Ground of Rejection to be Reviewed on Appeal
III.	Argument
IV.	Conclusion

I.   STATUS OF CLAIMS

The status of claims remains as identified in the Appeal Brief submitted December 1, 2005.

II.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

In the Examiner's Answer, the rejection of claim 11 under 35 U.S.C. §112, second paragraph is withdrawn, *see* page 3 of the Examiner's Answer. Therefore, the grounds of rejection that remain to be reviewed on appeal are:

Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,732,156 to Miloslavsky (hereinafter "*Miloslavsky*") in view of U.S. Patent No. 6,757,830 issued to Tarbotton et al. (hereinafter "*Tarbotton*").

III.   ARGUMENT

Appellant respectfully traverses the outstanding claim rejections and requests that the Board reverse those rejections in light of the remarks presented below. Appellant hereby reasserts those arguments that are presented for the separately argued claims in the Appeal Brief. For brevity, however, Appellant does not repeat those arguments herein and submits the following supplemental remarks in reply to the Examiner's Answer.

Independent Claims 1 and 15 and Dependent Claims 3, 6, 11, 13, and 16

i. Applied Combination Fails to Teach or Suggest All Limitations

Independent claim 1 recites in part "receiving an email message at a first server; ... executing software on said first server to autonomously select an appropriate one of a plurality of distributed email servers for receipt of said email message based at least in part on said determined characteristic information of said user; and executing software on said first server to autonomously route said email message to the selected email server" (emphasis added). Similarly, independent claim 15 recites in part "processor for executing said software code to autonomously determine characteristic information of a user having submitted information included in said email message received via said communicative coupling, for executing said software code to autonomously select an appropriate one of a

<u>plurality of distributed email servers for receipt of said email message</u> based at least in part on the determined characteristic information of said user, and for executing said software code <u>to autonomously route said email message to the selected email server</u>" (emphasis added). For the reasons discussed more fully in Appellant's Appeal Brief, the combination of *Miloslavsky* and *Tarbotton* fails to teach or suggest these elements of claims 1 and 15.

In brief, *Miloslavsky* does not teach or suggest a plurality of distributed email servers, but instead teaches an email processing center 100 that includes a single email server 102. Thus, *Miloslavsky* does not teach or suggest autonomously selecting an appropriate one of a plurality of distributed email servers for receipt of an email message, and *Miloslavsky* does not teach or suggest autonomously routing the email message to the selected email server. Rather, *Miloslavsky* teaches a system that addresses routing of an email to an appropriate one of a plurality of support personnel that are all coupled to a single email server (server 102 of FIG. 1 of *Miloslavsky*). Indeed, the technique of *Miloslavsky* could be applied in conjunction with embodiments of the present invention. For instance, once the email is routed to the appropriate email server (according to embodiments of the present invention) the technique of *Miloslavsky* may be applied for routing the email received by the email server to a particular support person connected to the email server.

The Examiner's Answer asserts that the sole difference between the claimed invention and *Miloslavsky* is that *Miloslavsky* only shows one recipient mail server, and asserts that is because all the support persons in *Miloslavsky* are located in one processing center. *See* page 4 of the Examiner's Answer. The Examiner appears to surmise that one would be lead from the teaching of *Miloslavsky* to employ *Miloslavksy's* routing technique to route an email to a different email server if a plurality of email servers were employed. Appellant disagrees as discussed below.

Miloslavsky is solely focused on directing an email from an email server to one of a plurality of support personnel connected to the email server, similar to directing telephone calls received by a call center to one of various support personnel connected to a call distributor. *Miloslavsky* is not concerned with how an email is routed to the email server, but rather is directed to managing the handling of emails by a plurality of support personnel connected to a server once the emails are received by such server. Thus, if a plurality of

email servers are implemented, *Miloslavsky's* technique may be used at each email server for directing emails received at a respective server to ones of a plurality of support personnel connected to such server. *Miloslavsky* provides no teaching or suggestion whatsoever of employing a technique for autonomously selecting an email server to which an email should be routed, but instead is solely focused on how to manage handling of an email by support personnel once the email is received by an email server. As discussed further herein, *Miloslavsky* appears to face the same inefficiencies identified in the Background section of the present application in that it would appear to rely upon a support personnel to whom an email is directed from a given email server to determine that the email should be routed to another email server (assuming a plurality of email servers are implemented) and to manually route the email to such other server.

The Examiner's Answer goes on to assert that *Tarbotton* discloses that "e-mail users are unable to share a single server if they are not located in a central [location] and require respective mail servers", pages 4-5 of the Answer. However, contrary to this assertion by the Examiner, *Tarbotton* does not teach or suggest that email users are unable to share a single server if they are not located in a central location. While *Tarbotton* shows that different users may be connected to different email servers, it does not teach that geographically distributed users necessarily must have separate email servers. Nevertheless, as discussed below, employing a plurality of distributed email servers is known in the art. However, neither *Miloslavsky* nor *Tarbotton* teaches or suggests, autonomously selecting and routing emails to an appropriate email server. *Tarbotton* provides no such teaching or suggestion, and *Miloslavsky* solely addresses how to handle directing an email to support personnel connected to an email server once such email server receives the email.

In response to the arguments presented in Appellant's Appeal Brief, the Examiner's Answer asserts (on page 6 thereof) that Appellant has argued against the references individually, rather than attacking the "combination" of the references. However, Appellant has addressed each reference individually in Appellant's Appeal Brief, in part, because the Final Office Action mailed July 7, 2005 asserts that *Miloslavsky's* computers 122 and 124 meet the limitation of a plurality of distributed email servers, <u>even without the teaching of the</u> <u>secondary reference *Tarbotton*</u>. The assertion in such Final Office Action is simply inaccurate for the reasons argued for *Miloslavsky* individually. Further, Appellant goes on to

argue that because the individual teachings of *Miloslavsky* and *Tarbotton* fail to teach or

suggest certain elements of the claims, the resulting combination of the references also fails

to teach or suggest these elements. As such, Appellant has addressed the resulting

combination of the references, and not merely each reference in isolation.

The Examiner's Answer further asserts (on pages 6-7 thereof):

> The Examiner relies on Tarbotton for the teaching that if the support
> persons in Miloslavsky are connected for communication by WAN or Internet
> (use wide area communication for outsourcing to other parts of the world) like
> the one (6) used in Figure 1 of Tarbotton instead of a LAN like the one (128)
> used in Figure 1 of Miloslavsky, a respective mail server (8 and 12 in Figure 1
> of Tarbotton) is required for each support person.

While FIG. 1 of *Tarbotton* shows a recipient email server 12 and a recipient 4

connected thereto, *Tarbotton* does not teach that a separate email server 12 need be

implemented for each individual person that is to receive emails, such as each support person

in the system of *Miloslavsky*. Rather, as is well known in the art, many persons may be

supported by a single email server. Indeed, the system of *Miloslavsky* is implemented such

that multiple support persons are connected to a single email server. Nothing in *Tarbotton*

precludes a plurality of persons being connected to e-mail server 12. Thus, *Tarbotton* does

not teach or suggest that each e-mail recipient is required to have a separate e-mail server in

order to receive e-mails. While *Miloslavsky* employs a LAN for connecting its support

persons to a given email server, neither *Miloslavsky* nor *Tarbotton* teaches or suggests that

support persons could not likewise be connected to a common email server via a WAN (e.g.,

the Internet).

The Examiner's Answer further asserts (on page 7 thereof):

> Figure 1 in Miloslavsky teaches that a server is required in order to
> communicate using a network. If one of the support person is in Japan and the
> other one in the United States, it would have been obvious to a person of
> ordinary skill in the art to provide a separate server for each one of them
> because they can not share a single server because of the distance apart.

First, no teaching or suggestion is made in the applied references that different users

cannot share a single server over a long distance, such as over a WAN. Further, as discussed

briefly below, *Miloslavsky* addresses routing emails from an email server to appropriate

support personnel that are connected to a given email server. *Miloslavsky* does not address how to route an email to an appropriate email server in the first place, but instead is solely focused on routing the emails to support personnel connected to an email server. Further, even assuming, *arguendo*, that *Tarbotton* discloses a plurality of email servers, it too fails to address any techniques for autonomously selecting and routing emails to one of the email servers as recited by claim 1.

As the Background section of the present application explains, employing separate email servers for geographically distant support personnel is well known. For instance, one email server may be employed for support personnel in the U.S., while another email server is employed for support personnel in Japan. However, as the Background of the present application goes on to explain, one such email server is traditionally designated a default email server that receives all email directed to the support personnel. For instance, the U.S. email server may be designated as the default server that receives all email. The email received at such U.S. email server may then be accessed by support personnel in the U.S. (e.g., using techniques as in *Miloslavsky*), and the recipient support personnel may manually determine that the email should be handled by support personnel connected to a different email server (such as support personnel connected to the Japan email server) and therefore reroute the email to such different email server.

The combination of *Miloslavsky* and *Tarbotton* fails to recognize or address the inefficiencies of such manual selection of an appropriate email server by support personnel. Instead, *Miloslavsky* merely addresses how, once an email is routed to an email server, the email may be directed to support personnel who are connected to the email server. The Examiner relies upon *Tarbotton* as teaching that a plurality of email servers may be employed. Even assuming this is true, *Tarbotton* does not teach or suggest any autonomous techniques for selecting one of the email servers to which an email should be routed, as recited by claim 1. Thus, if one were to combine the teachings of *Miloslavsky* and *Tarbotton* as suggested by the Examiner, an email may be received by one of a plurality of email servers (e.g., a default email server), and once received by an email server, the techniques of *Miloslavsky* may be employed to direct the received email from the server to one of a plurality of support personnel connected to the server. As discussed in the Background section of the present application, the support personnel to whom the email is directed may

manually determine that the email should be sent to another of the plurality of email servers and then manually re-route the email. Again, neither *Miloslavsky* nor *Tarbotton* teach or suggest autonomously selecting one of a plurality of distributed email servers for receipt of an email message and autonomously route the email message to the selected email server, as recited by claim 1.

Thus, while the techniques of *Miloslavsky* may be employed to address emails received at a given email server to an appropriate one of a plurality of support personnel connected to the given email server, neither of the applied references teaches or suggests autonomously selecting one of a plurality of distributed email servers to which the email should be routed in the first place. Thus, as discussed above, the applied combination of *Miloslavsky* and *Tarbotton* fails to teach or suggest all elements of claim 1, but instead the combination would appear to employ the traditional technique discussed in the Background of the present application in which an email received at an email server is directed to a support personnel who then must manually determine whether the email should be sent to a different email server for handling by support personnel connected to such different email server.

In view of the above, neither *Miloslavsky* alone, nor the combination of *Miloslavsky* and *Tarbotton* teaches or suggests all elements of claims 1 and 15, and therefore Appellant respectfully requests that the rejection of claims 1 and 15 under 35 U.S.C. § 103(a) be overturned.

ii. No Motivation to Modify the Combination for Achieving the Claim Limitations

Appellant further maintains that no motivation has been established for combining the *Miloslavsky* and *Tarbotton* references. For instance, as discussed above, *Tarbotton* does not require separate e-mail servers for each recipient, contrary to the assertion by the Examiner. Further, merely because support persons may be located in different remote areas does not require separate e-mail servers for those persons to be able to receive e-mails. For instance, support persons could access an e-mail server from a remote location for retrieving e-mails from such e-mail server. Thus, even if the support persons in *Miloslavsky* were located remote from e-mail server 102, such support persons could still access e-mail server 102 via communication network 128. Accordingly, the motivation recited in the February 9th Office

Action and in the Examiner's Answer is improper because separate e-mail servers would not be required for support personnel to be able to receive e-mails even if the support personnel were located in different remote areas.

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, *see* M.P.E.P. § 2143.01. Additionally, the prior art must suggest the desirability of the claimed invention, *see* M.P.E.P. § 2143.01. "There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination" and "[t]hat knowledge can not come from the applicant's invention itself." *In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992). Further, it is insufficient to prove that at the time of the claimed invention, the separate elements of the device were present in the known art. Rather, there must have been some explicit teaching or suggestion in the art to motivate one of even ordinary skill to combine such elements so as to create the same invention. *See Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 U.S.P.Q.2d 1294 (Fed. Cir. 1997).

As discussed above, no proper motivation for modifying the applied references to achieve the claim elements, particularly a plurality of distributed email servers, has been provided by the February 9th Office Action or the Examiner's Answer.

Further reasons regarding why insufficient motivation is present in the current rejection are presented in Appellant's Appeal Brief.

Therefore, the rejection under 35 U.S.C. § 103(a) should be overturned.

Dependent claims 3, 6, 11, 13, and 16 each depend either directly or indirectly from one of independent claims 1 and 15, and thus inherit all limitations of the respective independent claim from which they depend. It is respectfully submitted that dependent claims 3, 6, 11, 13, and 16 are allowable at least because of their dependency from their respective independent claims for the reasons discussed above, but also in view of their novel claim features.

Dependent Claim 5

Dependent claim 5 recites "said user submitting information to a web server; and said web server creating an email message to communicate the submitted information to said first server". In response to Appellant's arguments in the Appeal Brief, the Examiner's Answer merely asserts (on page 7 thereof) that:

> As to claim 5, in lines 42-59 of column 4, Miloslavsky teaches that are submitted by the users to a web server. Email creating is inherent in email communication.

First, lines 42-59 of column 4 of *Miloslavsky* in no way teaches or suggests information submitted by users to a web server. Instead, this portion of *Miloslavsky* addresses types of information that an extractor 204 may extract from emails.

Further, the mere allegation by the Examiner is insufficient to establish inherency. In order to properly establish that an element is inherently included within the applied references, "the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art," M.P.E.P. § 2112, citing *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis original). Here, the Examiner has failed to provide such a basis in fact and/or technical reasoning.

Claim 5 recites "said web server creating an email message", and the Examiner's Answer merely alleges (incorrectly) that *Miloslavsky* teaches that a user can submit information to a web server and that creating an email is inherent in email communication. This fails to even assert that *Miloslavsky* teaches or suggests a web server creating an email message.

Thus, the rejection of claim 5 should be overturned.

Claims 7-12

In response to Appellant's Appeal Brief, the Examiner's Answer asserts that Appellant fails to provide any supporting arguments as to why claims 7-12 are patentable over the applied references. Appellant disagrees. Appellant has clearly asserted in the

Appeal Brief that the applied references fail to teach or suggest each and every element of these claims. Further, the burden is on the Examiner to establish that the applied references teach or suggest all elements of the claims. The Examiner has failed to so establish such teaching or suggestion by the applied references, and instead appears to be attempting to place the burden on Appellant to establish that the applied references do not teach or suggest all elements of the claims.

For instance, in the Examiner's Answer regarding claims 7-12, the Examiner fails to identify any teaching or suggestion of the elements of these claims in the applied references, and fails to provide any motivation for modifying the references to include such elements. Instead, the Examiner's Answer merely asserts at pages 5-6 thereof:

> As to claims 7-12, in view of the examples of support person selection criteria listed in item (a) to (i) of column 5, it would have been obvious to a person of ordinary skill in the art to apply any criteria, including geographical location, necessary to match a user and a support person.

This fails to establish a prima facie case of obviousness. "Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case." M.P.E.P. § 2141 (emphasis in original). Further, "[o]ffice policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103." M.P.E.P. § 2141. The factors of *Graham v. John Deere Co.* have not been established in the rejection of claims 7-12, but instead the Examiner's Answer alleges that "it would have been obvious … to apply any criteria" without providing any motivation for doing so, and without even identifying which elements of the rejected claims the "any criteria" even addresses.

Thus, the rejection of claims 7-12 is improper and should be overturned.

Remaining Claims

As to the remaining claims, Appellant respectfully reasserts the arguments raised in Appellant's Appeal Brief.

IV.   CONCLUSION

In view of the arguments raised in Appellant's Appeal Brief, and the further comments supplied herein in response to the Examiner's Answer, Appellant respectfully submits that the outstanding rejections of the pending claims are improper. Thus, Appellant respectfully requests that the Board overturn these rejections.

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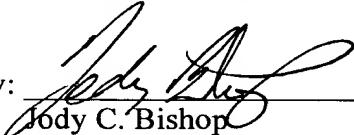
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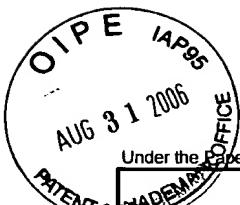
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TRANSMITTAL FORM

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Art Unit	2155
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ENCLOSURES *(Check all that apply)*

- [ ] Fee Transmittal Form
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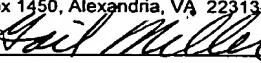- [ ] Licensing-related Papers
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- [ ] After Allowance Communication to TC
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Date	August 31, 2006	Reg. No.	44,034